PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Duvaut *et al.*

Serial No.: 10/626,714

Filed: July 25, 2003

Confirmation No.: 1895

Group Art Unit: 2611

Examiner: Tse, Young Toi

TKHR Ref: 060707-1450
Client Ref: GV234

For: **DBMSOL AND FBMSOL POWER SPECTRAL DENSITY MASKS**

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer, which was mailed October 17, 2007.

Response to Examiner's Answer

Applicants continue to disagree with the Examiner's positions as to all claims presently rejected. Applicants' Appeal Brief sets forth, from a substantive basis, the reasons why claims 1-28 are directed to patentable subject matter under 35 U.S.C. § 101. In the Grounds for Rejection section on pages 3-4, the Examiner reiterates substantially the same arguments set forth by the Examiner in the FINAL Office Action.

In the "Response to Argument" section starting on page 4, the Examiner addresses some of the arguments raised by the Applicants in Applicants' Appeal Brief.

Notably, the Examiner addresses applicability of the Federal Circuit's decision in *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994). In particular, the Examiner argues:

> "In In Re Warmmerdam [sic], claim 5 is statutory under 35 U.S.C. §101 because claim 5 not only includes a machine, the machine also having [sic] a memory which contains [specific] data representing a bubble hierarchy generated by the method of claim 1. In contrast, claims 1 and 2 recite a digital subscriber line (DSL) communications system without claiming further element(s) or device(s) configured to provide a power spectral density (PSD) mask for spectral shaping . . ."

(Emphasis added; Examiner's Answer, page 5). While the Examiner appears to interpret the holding of *In re Warmerdam* as requiring multiple elements/devices, the court in *Warmerdam* concluded that "Claim 5 is for a machine, and is clearly patentable subject matter." *In re Warmerdam* at 1360. The court did not explicitly state the requirement for "claiming further element(s) or device(s)" in order to meet the threshold for patentability under §101. Patent protection was ultimately granted to a memory storing a data structure (but not to the data structure itself). Indeed, in *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994), the Federal Circuit confirmed that a data structure stored in a memory was statutory subject matter (in addition to holding that the data structure was patentable over the prior art). Claim 1 in *In re Lowry* recited:

> 1. *A memory for storing data* for access by an application program being executed on a data processing system, comprising:
> *a data structure stored in said memory*, said data structure including information resident in a database used by said application program and including:
> a plurality of attribute data objects . . .
> a single holder attribute data object . . .
> a referent attribute data object . . . and
> an apex data object . . .

Similarly, independent claims 1 and 15 recite "A Digital Subscriber Line (DSL) communications system configured to provide a power spectral density (PSD) mask ..."

This additional language, clearly brings these claims into the realm of patentable subject matter (even if the remainder of the claims is considered to be nothing more than a mathematical algorithm). Applicants explicitly directed claims 1 and 15 to a Digital Subscriber Line (DSL) communications system.

Notwithstanding Applicants' previous arguments to the Examiner, the Examiner states that the Examiner consulted the "TC-specific 101 Help Panel" composed of individuals from the U.S. PTO. (Examiner's Answer, page 4). The Examiner has relied on the determination of this panel in maintaining the rejections under 35 U.S.C. § 101. Although Applicants understand the Examiner's action in giving deference to his employing supervisors, the rejection is misplaced. The PTO does not have overriding authority (over the Federal Circuit) with regard to statutory interpretation, and certainly no panel of individuals of the U.S. PTO has the authority to disregard clear precedence from the Federal Circuit to arrive at inconsistent determinations with regard to material that is statutorily patentable subject matter.

Simply stated, the Applicants and the Examiner have a fundamental disagreement as to the appropriateness of the §101 rejection set forth. As is clear from the express language of the claims, both claims 1 and 15 are directed to a Digital Subscriber Line (DSL) communications system. As such, the claims are clearly patentable subject matter under 35 U.S.C. § 101. For at least the reasons fully set forth in the Appeal Brief, Applicants respectfully submit that the Board should overturn the rejections of the Examiner.

No fees are believed to be due in connection with this Reply Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 50-0835.

Respectfully submitted,

/Daniel R. McClure/

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